

in the United Kingdom on December 8, 1998; however, the Examiner states that "no copy can be found."

Applicant herein encloses an additional certified copy of Great Britain Application No. 9827016.8, filed on December 8, 1998. A proper claim under 35 U.S.C. § 119 should be secured. Thus, Applicant respectfully requests the reconsideration and withdrawal of this objection.

**Rejection of Claim 5 Under 35 U.S.C. § 112, ¶2**

Claim 5 is rejected under 35 U.S.C. § 112, second paragraph, for allegedly being "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." The Examiner states that the "specification does not set forth any degree of specificity that a 'probe' must have."

To facilitate prosecution on the merits of the instant application, Applicant respectfully overcomes this rejection by amending claim 5. Amended claim 5 is drawn to polynucleotide probes comprising an oligomer of SEQ ID NO:4-19, wherein said probe does not differ in sequence from a polynucleotide encoding a polypeptide of SEQ ID NO:2 or fragment of said polynucleotide. Support for amended claim 5 may be found on page 1, lines 27-28, of the specification, and in Figure 3. Applicant asserts that amended claim 5 contains a sufficient degree of probe specificity as the probe is drawn to polynucleotides encompassing the stated sequences that also encode the polypeptide of SEQ ID NO:2, or fragments thereof. Applicant respectfully requests the reconsideration and withdrawal of the instant indefiniteness rejection as to claim 5.

**Rejection of Claim 5 Under 35 U.S.C. § 112, ¶1**

Claim 5 is rejected under 35 U.S.C. § 112, first paragraph, for allegedly not providing enablement "for polynucleotides comprising an oligomer of SEQ ID NO:4-19, wherein said probe differs in sequence from a polynucleotide encoding a polypeptide of SEQ ID NO:2." The Examiner states that the invention is not commensurate in scope with the claim and that claim 5 contains subject matter "which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

Applicant respectfully overcomes this rejection by amending claim 5. As stated above, amended claim 5 is drawn to polynucleotide probes comprising an oligomer of SEQ ID NO:4-19, wherein said probe does not differ in sequence from a polynucleotide encoding a polypeptide

of SEQ ID NO:2 or fragment of said polynucleotide. Applicant asserts that amended claim 5 is commensurate in scope with the invention and respectfully requests withdrawal of this rejection.


**Rejection of Claims 1, 3, 5, 7, 8, and 9 Under 35 U.S.C. § 102(a) and § 102(e)**

Claims 1, 3, 5, 7, 8, and 9 are rejected under 35 U.S.C. § 102(a) and § 102(e) as being anticipated by Caterina et al. (1999, *Nature* 398:436-441) and Patent No. 6,335,180, filed January 22, 1999, respectively. Both Caterina et al. and the reference patent disclose polynucleotides comprising the coding region of the polynucleotide of SEQ ID NO:1 of the present invention, probes specific to said polynucleotide, and methods of making a polypeptide.

Applicant respectfully overcomes the above rejection by perfecting the priority of the instant application under 35 U.S.C. § 119 to Great Britain Application No. 9827016.8, filed on December 8, 1998. This claim to priority is supported by the Declaration and Power of Attorney submitted with the filing of the instant application. Applicant herein encloses a certified copy of said priority application that predates that of the above-cited references. Thus, Applicant submits that the disclosures of Caterina et al. and the reference patent, '180, are not appropriate prior art to maintain the § 102(a) or § 102(e) rejections. Applicant respectfully requests the reconsideration and withdrawal of the instant rejection.

Based on the amendments and comments herein, Applicant respectfully takes the position that claims 1, 3, 5, and 7-9 are in proper form for allowance. Early action to that end is earnestly solicited. Examiner is invited to contact the undersigned attorney if clarification is required on any aspect of this response, or if any of the claims are considered to require further amendment to be placed in condition for allowance after entry of this Amendment.

Respectfully submitted,

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**IN THE SPECIFICATION:**

-- This application claims priority to GB Application No. 9827016.8, filed December 8, 1998, now abandoned.

**IN THE CLAIMS:**

Claim 5 was amended as follows:

5(Three Times Amended). A polynucleotide probe comprising an oligomer [selected from the group consisting] of SEQ ID NO:4-19, wherein said probe does not differ in sequence from a polynucleotide encoding a polypeptide of SEQ ID NO:2 or fragment of said polynucleotide.